

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1, 38, 75, 80 and 84-85 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-2, 4-11, 13-36, 38-39, 41-55, 57-73, 75, 77-78, 80-85 are pending and under consideration. Reconsideration is respectfully requested.

OBJECTIONS TO THE CLAIMS:

In the Office Action, at page 2, numbered paragraph 2, claims 84 and 85 were objected to because of informalities.

Inadvertently, claims 84 and 85 showed dependencies to claims 1 and 38 instead of 75 and 80. Claims 84 and 85 have been amended to correct these errors.

Hence, it is respectfully submitted that amended claims 84-85 are now in allowable form.

REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at page 2, numbered paragraph 3, claims 1, 2, 4-11, 13-36, 38, 39, 41-55, 57-73, 75, 77-78 and 80-85 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

The terminology “capable of” and “can be,” respectively, have been deleted from independent claims 1, 38, 75 and 80, respectively. Thus, claims 1, 38, 75 and 80 are submitted to be in correct form under 35 U.S.C. §112, second paragraph.

Since claims 2, 4-11, 13-36, 39, 41-55, 57-73, 77-78, and 81-85 depend from amended independent claims 1, 38, 75 and 80, respectively, claims 2, 4-11, 13-36, 39, 41-55, 57-73, 77-78 and 81-85 are submitted to be in allowable form under 35 U.S.C. §112, second paragraph, for at least the reasons that amended claims 1, 38, 75 and 80 are in allowable form under 35 U.S.C. §112, second paragraph.

REJECTION UNDER 35 U.S.C. §103:

A. In the Office Action, at pages 3-9 and 10, numbered paragraphs 7 and 9-10, claims 1, 2, 4-11, 13-36, 38, 39, 41-55, 57-73, 75, 77-78, 80 and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norihiko (JP Publication Number: 11-242545; hereafter, Norihiko) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482; hereafter, Nishimoto). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Independent claims 1, 38, 75 and 80 have been amended. It is respectfully submitted that the amendments of claims 1, 38, 75 and 80 overcome the rejection of claims 1, 2, 4-11, 13-36, 38, 39, 41-55, 57-73, 75, 77-78, 80 and 81 since claims 2, 4-11, 13-36, 38, 39, 41-55, 57-73, 77-78 and 81 depend from amended claims 1, 38, 75 and 80, respectively (see below).

In the present invention, a transmitted message is distinguished from received messages. For clarifying this feature, the phrase --the degree of importance of the keyword is not raised when an occurrence of the received message containing the keyword has been detected but an occurrence of a transmitted message which has been prepared in said apparatus in response to the received message containing the keyword has not been detected-- has been added to independent claim 1, and similarly, to independent claims 38, 75 and 80 (see FIG. 3, S210-S214). In other words, the degree of importance of the keyword is lowered or maintained in response to an occurrence of the received message containing the keyword has been detected if it is determined that an occurrence of a transmitted message which has been prepared in said apparatus in response to the received message containing the keyword has not been detected. In addition, the phrases --the keywords being stored in said memory and used only for a user of the said message transmitting and receiving apparatus--, and --wherein the keywords stored in said memory are used for indicating to the user of said message transmitting and receiving apparatus, an occurrence of a received message from another apparatus containing the keyword stored in said memory-- have also been added to independent claim 1, and similarly to independent claims 38, 75, and 80.

Norihiko (JP H11-242545 A) discloses extracting utterances for indication to a user that include particular words determined by the user or satisfy other conditions determined by the user, for the purpose of facilitating keeping track of conversation in the chat system, and raising priorities of words in a dictionary for indication in accordance with frequencies of the words appearing within the extracted utterances, wherein the particular words may be selected by the user in accordance with the priorities. However, Norihiko fails to disclose determining priorities of the words for determining indication of an utterance which may be important to a user in accordance with the user's response of transmitting an utterance in response to another utterance received from another user.

Nishimoto et al (JP H10-69482) discloses determining a potential topic in a conversation among users in accordance with frequencies of words and the like appearing in conversation, in which uttered objects of a plurality of users are merged for evaluation. In Nishimoto, a transmitted uttered object in the instant apparatus is not distinguished from received uttered objects transmitted by other apparatuses.

Neither Norihiko nor Nishimoto discloses or suggests the feature of the present invention

as called for in amended independent claims 1, 38, 75 and 80 of the present invention.

As noted by the Examiner, Norihiko does not explicitly disclose the degree of importance of the keywords changes in accordance with time. Nishimoto teaches a topic processing device for invigorating a conversation among multiple conversants wherein weights of respective key words are assessed based on appearance frequencies and appearance intervals of the extracted respective key words. However, it should be noted that Nishimoto, in paragraph [0029] on page 24, recites: "... as far as the present invention is concerned, the statements of the respective participants are individually subjected, as statement objects, to morphospecies analyses, whereas certain types of words alone are extracted, as key words, from the obtained results...." Hence, Nishimoto does not select key words in the same manner as key words are selected in the present invention.

Thus, even if combined, Norihiko and/or Nishimoto, alone or in combination, do not teach or suggest amended claims 1, 38, 75 and/or 80 of the present invention. In addition, it should be noted that in Ruiz and Foundation v. A.B. Chance Company, 69 USPQ2d 1690 (CAFC January 29, 2004), the court held:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of **hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.**

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. (emphasis added)

There has been no reason given for combining Norihiko and Nishimoto. It is respectfully submitted that the courts have held: "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

Thus, it is respectfully submitted that there is no teaching or suggestion of combining Norihiko and Nishimoto, and even if combined, the combination would not recite the present claimed invention as recited in amended independent claims 1, 38, 75 and/or 80 of the present invention.

Thus, amended independent claims 1, 38, 75 and 80 are submitted to be patentable under 35 U.S.C. §103(a) over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482), alone or in combination.

Since claims 2, 4-11, 13-36, 39, 41-55, 57-73, 77-78, and 81 depend from amended claims 1, 38, 75 and 80, respectively, claims 2, 4-11, 13-36, 39, 41-55, 57-73, 77-78, and 81 are submitted to be patentable under 35 U.S.C. §103(a) over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482), alone or in combination, for at least the reasons amended claims 1, 38, 75 and 80 are patentable under 35 U.S.C. §103(a) over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482), alone or in combination.

B. In the Office Action, at pages 9-10, numbered paragraphs 8-10, claims 82-85 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norihiko (JP Publication Number: 11-242545; hereafter, Norihiko) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482; hereafter, Nishimoto) and further in view of Payton (USPN 6,681,247 B1; hereafter, Payton). The reasons for the rejection are set forth in the Office Action and therefore not repeated.

It is respectfully submitted that Payton (USPN 6,681,247) discloses monitoring and analyzing user activities to track user interests and diffuse user interests to information resources that have not been visited. In Payton, scores are generated for items of information accessed actively by a user, but not for messages received from other users.

Hence, neither Norihiko, Nishimoto (see above) nor Payton discloses or suggests the feature of the present invention as called for in amended independent claims 1, 38, 75 and 80 of the present invention.

Thus, amended independent claims 1, 38, 75 and 80 are submitted to be patentable under 35 U.S.C. §103(a) over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482) and further in view of Payton (USPN 6,681,247 B1).

Since claims 82-85 depend from amended independent claims 1, 38, 75 and 80, respectively, claims 82-85 are submitted to be patentable under 35 U.S.C. §103(a) over Norihiko

(JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482) and further in view of Payton (USPN 6,681,247 B1) for at least the reasons that amended independent claims 1, 38, 75 and 80 are patentable under 35 U.S.C. §103(a) over Norihiko (JP Publication Number: 11-242545) in view of Nishimoto et al. (Japanese Patent, Document No. H10-69482) and further in view of Payton (USPN 6,681,247 B1).

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: February 3, 2006 By: Darleen J. Stockley
Darleen J. Stockley
Registration No. 34,257

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501